

REMARKS

Claims 1 and 67 to 122 were pending in the application at the time of examination. Claim 1 stands provisionally rejected under 35 U.S.C. §101 for double patenting. Claims 67, 83, 100 and 111 stand provisionally rejected for obviousness-type double patenting. Claims 108-110 are objected to for improper dependent form. Claims 1, 67, 68, 71, 75, 83, 84, 85, 88, 92, 100, 101, 104, 108, 111, 112, 113, 116, and 120 stand rejected as obvious. Claims 69, 70, 72 to 74, 76 to 82, 86, 87, 89 to 91, 93 to 99, 102, 103, 105 to 107, 109, 110, 114, 115, 117 to 119, 121, and 122 stand objected to for being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Responsibility for the above application has been transferred to the undersigned Attorney. Please direct all further correspondence to the undersigned attorney. A Revocation of Attorney and Appointment of New Attorney is being submitted under separate cover.

Applicants have amended the description to properly reflect the status of the application cited as a Related Application. Applicants have also amended the application to show that the instant application is a continuing application of another application.

Claims 108 to 110 stand objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form. The Examiner correctly interpreted that Claim 108 should depend from Claim 100. Claim 108 has been amended to show the correct dependency. Reconsideration and withdrawal of the objection to Claims 108 to 110 is respectfully requested.

Applicants note that no § 112 rejections have been given and so in the Examiner's opinion the claims comply with the requirements of § 112. Nevertheless, upon review of the

claims, Applicants noted several antecedent basis informalities. Applicants amended Claims 69, 70, 72 to 74, 78 to 82, 86, 87, 89 to 91, 95 to 99, 102, 103, 105 to 108, 114, 115, and 117 to 119 to correct these informalities. Since the amendments correct informalities and no substantive §112 rejections were given, Applicants respectfully submit that the amendments do not affect the patentability of the claims.

Claim 1 stands provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of Claim 1 of copending U.S. Patent Application Serial No. 09/947,781. Applicants have canceled Claim 1. Accordingly, this rejection is rendered moot. Applicants respectfully request reconsideration and withdrawal of the §101 same invention rejection.

Claims 67, 83, 100 and 111 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 17, 34 and 50 of copending U.S. Patent Application Serial No. 09/947,781. The Examiner stated in part "the only different [Sic] between the instant application and the copending application is the instant application claims an apparatus for dynamic implementation of Java Metadata Interface to a metamodel while the copending application claims a method for dynamic implementation of Java Metadata Interface to a metamodel."

Applicants respectfully traverse the provisional obviousness-type double patenting rejection. The Examiner rationale goes against the common practice of issuing restriction requirements between method and apparatus claims. Following the Examiner's rationale, every restriction requirement would be improper because the resulting application would be subject to an obviousness-type double patenting rejection because one was directed to a method and the other to

an apparatus. This is clearly not the case as evidenced by the Patent Office practice.

Applicants respectfully submit that to support this rejection, the Examiner must show that restriction would not have been proper in the instant application. According to the MPEP:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus . . .
(MPEP §806.05(e))

The rejection fails to establish that the processes of Claims 1 and 17 in the parent application cannot be practiced by another materially different apparatus from that recited in Claims 100 and 111, for example. Thus, Applicants respectfully submit that a proper basis for the obviousness-type double-patenting rejection has not been established for these claims.

Similarly, Claims 34 and 50 in the parent application are directed to a computer program product. Applicants respectfully request reconsideration and withdrawal of the obviousness-type double patenting rejection.

Finally, Applicants note that the equivalent rejection has been given in the copending parent application. Applicants respectfully submit that the rejection is proper in only one of the two applications. Both should not be subject to a terminal disclaimer. For example, if the instant application had issued prior to the obvious-type double patenting rejection, the obviousness-type double patenting rejection would only be given in the later pending application. Since it is unknown whether either application will issue and which will be the first to issue, Applicants respectfully submit that even though the rejection is provisional, it is premature. If the obviousness-type double patenting rejection is not withdrawn, Applicants request in the alternative that the rejection be suspended

until a notice of allowance is issued in one of the applications. At that time, the rejection can be reinstated in the other of the applications.

Claims 1, 67, 83, 84, 100, and 111 to 112 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Admitted Prior Art in view of "Dynamic Proxy Classes" of Sun Microsystems, Inc. The Examiner stated in part:

12. . . . Sun teaches a dynamic proxy class that implements a list of interfaces specified at runtime when the class is created (page 1).

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of the APA and Sun because it will improve the performance of APA' system because it does not required [Sic] pre-generation of the proxy class, such as with compile-time tools.

Claim 1 had been canceled and so the obviousness rejection is rendered moot.

Applicants respectfully traverse the obviousness rejection of Claim 67. Applicants note that the MPEP requires:

2143.03 All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art."

MPEP § 2143.03, Eighth Edition, Rev. 2, P. 2100-133 (May, 2004)

The rejection as noted above demonstrates that all words in Claim 1 were not considered. In particular, Claim 1 recites in part:

means for receiving a JMI implementation request,
said request associated with a metamodel, said metamodel comprising at least one package, said at least one package comprising at least one class, said at least one class comprising at least one attribute, reference or operation;
means for implementing a package proxy JMI interface when said request comprises a package proxy request;
means for implementing a class proxy JMI interface when said request comprises a class proxy request; and
means for implementing a class instance JMI interface
when said request comprises a class instance request.
(Emphasis added.)

The rejection has cited no teaching or suggestion of means for dynamically implementing the first and last operations, of means for dynamically varying the implementing based upon the JMI implementation request received, or of the combination of the four means with the recited functionality of each as recited in Claim 67. At best, the rejection addresses only a portion of some of the recited limitations with respect to proxies, and this assumes arguendo that the combination of references is correct. Applicants respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 67.

Applicants respectfully traverse the rejection of Claim 83. The above comments and quotation from the MPEP are incorporated herein by reference. Moreover, in an obviousness rejection, the Examiner is required to consider inherent properties as disclosed in the specification.

DISCLOSED INHERENT PROPERTIES ARE PART OF "AS A WHOLE" INQUIRY

"In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification.

MPEP § 2141.02, Eighth Edition, Rev. 2, P. 2100-126 (May, 2004)

Claim 83 recites in part:

means for receiving a JMI implementation request, said request associated with a metamodel, said metamodel comprising at least one package, said at least one package comprising at least one class, said at least one class comprising at least one attribute, reference or operation;
means for implementing a JMI interface when said JMI interface is unimplemented; and
means for executing a stored JMI interface implementation when said JMI interface is implemented.

The secondary reference relied upon by the Examiner teaches at most operations for a specific proxy class and fails to teach or suggest "means for implementing a JMI interface" or "means for executing a stored JMI interface," when the inherent properties of the JMI interface and the metamodel are considered as recited in the claim, e.g., "at least one class comprising at least one attribute, reference or operation." Each of the other means includes these class instances. Accordingly, the combination fails to teach every Claim limitation. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 83.

Claim 84 depends from Claim 83 and so distinguishes over the combination of references for at least the same reasons as Claim 83 given above, and incorporated herein by reference. In addition, the comments with respect to Claim 67 are also applicable to Claim 84 and are incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of Claim 84.

Applicants respectfully traverse the obviousness rejection of Claim 100. The above remarks concerning Claim 67 and the prior art are applicable to Claim 100 and are incorporated herein by reference. Applicants respectfully request

reconsideration and withdrawal of the obviousness rejection of Claim 100.

Applicants respectfully traverse the obviousness rejections of Claims 111 and 112. The above remarks concerning Claim 83 and the prior art are applicable to Claim 111 and are incorporated herein by reference. Similarly, the above remarks concerning Claim 84 and the prior art are applicable to Claim 112 and are incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 111 and 112.

Claims 68, 71, 75, 85, 88, 92, 101, 104, 108, 113, 116, and 120 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Admitted Prior Art in view of "Dynamic Proxy Classes" of Sun Microsystems, Inc., and further in view of U.S. Patent No. 6,385,661 B1, hereinafter Guthrie.

Applicants note that the information cited in Guthrie does not overcome the basic deficiencies in the primary combination noted above. Accordingly, each of Claims 68, 71, 75, 85, 88, 92, 101, 104, 108, 113, 116, and 120 distinguish over the combination of references for at least the same reason as the independent claim upon which they depend. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 68, 71, 75, 85, 88, 92, 101, 104, 108, 113, 116, and 120.

Applicants note that the Examiner indicated that Claims 69, 70, 72 to 74, 76 to 82, 86, 87, 89 to 91, 93 to 99, 102, 103, 105 to 107, 109, 110, 114, 115, 117 to 119, 121 and 122 recite patentable subject matter. However, in view of the patentability of the independent Claims, Applicants have not amended these claims at this time to include the limitations of the claims upon which they depend.

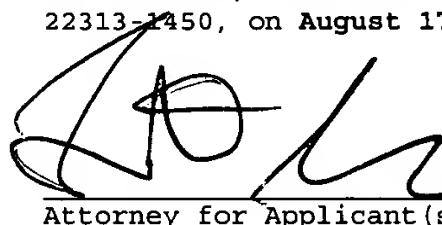
Claims 67 to 122 remain in the application. Claim 1 is canceled. Claims 2 to 66 were previously canceled. Claims 69, 70, 72 to 74, 78 to 82, 86, 87, 89 to 91, 95 to 99, 102, 103,

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105 to 108, 114, 115, and 117 to 119 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 17, 2004.



Attorney for Applicant(s)

August 17, 2004
Date of Signature

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